REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed on November 17, 2008 (Paper No. 20081109). Upon entry of this response, claims 1-29 are pending in the application. In this response, claims 1-4, 9-12, 16, 18-19, and 24 have been amended. Applicants respectfully request that the amendments being filed herewith be entered and request reconsideration and allowance of all pending claims.

I.   Claim Rejections under 35 U.S.C. §102(e)

Claims 1-29 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 7,296,870 issued to *Tyson* et al. (hereafter "*Tyson*"). Applicants respectfully traverse this rejection as applied to pending claims 1-29.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the amended claims is represented in the *Tyson* reference.

A.   Independent Claim 1

Applicants' amended claim 1 provides as follows (emphasis added):

> A method, comprising:
>   receiving a document for printing in an image forming device, wherein a print mode setting is associated with the document; and
>   printing at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where **the print mode actuator includes at least an application state and a monochromatic override state**.

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 1.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in amended claim 1.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 1. Therefore, Applicants respectfully submit that the rejection of claim 1 be withdrawn.

B.   Dependent Claims 2-8

Since independent claim 1 is allowable, Applicants respectfully submit that claims 2-8 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicants respectfully request that the rejection of claims 2-8 be withdrawn.

C.   Dependent Claim 5

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 5 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 5. Applicants' claim 5 provides as follows (emphasis added):

> The method of claim 1, further comprising:
> implementing an execution of a raster image processing of the

document, wherein the raster image processing is of one of a monochromatic raster image processing or a color raster image processing;

detecting a change in the state of the print mode actuator during the execution of the raster image processing of the document; and

transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.

The Office Action alleges on pages 4-5 that

Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*]); and transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

(Emphasis in original). Applicants respectfully disagree. Applicants respectfully submit that detecting a switch between modes is not the same as "detecting a change in the state of the print mode actuator'. Further, while *Tyson* states in claim 3:

A printer, comprising:
means for tracking a wear level of a color cartridge based on activity in color mode;
means for tracking a consumable use level of the color cartridge based on color consumables expended;
projecting a color cartridge failure mechanism to be either color cartridge wear-out or consumable exhaustion based on the wear level and the consumable use level; and
means for switching between color mode and monochrome mode to decrease likelihood of color cartridge wear-out before color consumables are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detecting a change in the state of the print mode actuator", much less "detecting a change in the state of the print mode actuator <u>during the execution of the raster image processing of the document</u>". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of

the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "detecting a change in the state of the print mode actuator during the execution of the raster image processing of the document" as recited in claim 5.

Nor does *Tyson* teach or suggest "transitioning the raster image processing of the document at a transition point". Accordingly, *Tyson* does not disclose or suggest "transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 5.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 5. Therefore, Applicants respectfully submit that the rejection of claim 5 be withdrawn.

D.   Dependent Claim 8

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 8 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 8. Applicants' claim 8 provides as follows (emphasis added):

> The method of claim 1, further comprising:
> executing one of a monochromatic raster image processing or a color raster image processing of the document;
> ***detecting a change in the state of the print mode actuator during the execution of the one of the monochromatic raster image processing or the color raster image processing of the document***; and
> completing the monochromatic raster image processing or the color raster image processing of the document even though a change in the state of the print mode actuator is detected that results in an inconsistency between the state of the print mode actuator and the raster image processing of the document that was in progress at the time of the change in the state of the print mode actuator.

The Office Action alleges on page 5 that "Tyson et al further teaches ... detecting a change in the state of the print mode actuator during the execution of the one of the

monochromatic raster image processing or the color raster image processing of the document

(see figs 4 and 5 and claims 2-8 [*sic*]**)**...” (emphasis in original). Applicants respectfully

disagree. While *Tyson* states in claim 3:

> A printer, comprising:
> means for tracking a wear level of a color cartridge based on activity
> in color mode;
> means for tracking a consumable use level of the color cartridge
> based on color consumables expended;
> projecting a color cartridge failure mechanism to be either color
> cartridge wear-out or consumable exhaustion based on the wear level
> and the consumable use level; and
> means for switching between color mode and monochrome mode to
> decrease likelihood of color cartridge wear-out before color consumables
> are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest “detecting a change in the state of the

print mode actuator”, much less “detecting a change in the state of the print mode actuator

during the execution of the one of the monochromatic raster image processing or the color

raster image processing of the document”. *Tyson* does not even mention raster image

processing. As is well established in the law, the Examiner must instead consider the claims as a

whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of

anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 -

must not only disclose all elements of the claim within the four corners of the document, but must

also disclose those elements “arranged as in the claim.” *Connell v. Sears*, Roebuck & Co., 722

F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest “detecting a change

in the state of the print mode actuator during the execution of the one of the monochromatic

raster image processing or the color raster image processing of the document” as recited in

claim 8.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of

the features recited in claim 8. Therefore, Applicants respectfully submit that the rejection of

claim 8 be withdrawn.

E.   **Independent Claim 9**

Applicants' amended claim 9 provides as follows (emphasis added):

> A program embodied in a computer readable medium, comprising:
>   code that identifies a print mode setting associated with a document received for printing in an image forming device; and
>   code that implements a printing of at least a portion of the document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where *the print mode actuator includes at least an application state and a monochromatic override state.*

Applicants respectfully submit that independent claim 9 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 9.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in amended claim 9.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 9. Therefore, Applicants respectfully submit that the rejection of claim 9 be withdrawn.

F.   **Dependent Claims 10-15**

Since independent claim 9 is allowable, Applicants respectfully submit that claims 10-15 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicants respectfully request that the rejection of claims 10-15 be withdrawn.

G.   Dependent Claim 13

Notwithstanding, and in addition to, the arguments discussed above, Applicants

respectfully request that the rejection of claim 13 be withdrawn for at least the reason that *Tyson*

fails to disclose, teach, or suggest at least the features recited and emphasized above in claim

13. Applicants' claim 13 provides as follows (emphasis added):

> The program embodied in the computer readable medium of claim 9,
> further comprising:
>   code that implements an execution of a raster image processing of
> the document, wherein the raster image processing is one of a
> monochromatic raster image processing or a color raster image
> processing;
>   ***code that detects a change in the state of the print mode actuator***
> ***during the execution of the raster image processing of the***
> ***document***, and
>   ***code that transitions the raster image processing of the***
> ***document at a transition point in response to the change in the state***
> ***of the print mode actuator.***

The Office Action alleges on pages 4-5 that

> Tyson et al further teaches ... detecting a change (**or switch**
> **between modes**) in the state of the print mode actuator during the
> execution of the raster image processing of the document (**see claims 2-**
> **8** [*sic*]); and transitioning the raster image processing of the document at
> a transition point in response to the change in the state of the print mode
> actuator (reads on claims 2-10 [*sic*] which describe how the state of the
> print can change based on the consumable and user's input).

(Emphasis in original).   Applicants respectfully disagree.   Applicants respectfully submit that

detecting a switch between modes is not the same as "detect[ing] a change in the state of the

print mode actuator'.   Further, while *Tyson* states in claim 3:

> A printer, comprising:
>   means for tracking a wear level of a color cartridge based on activity
> in color mode;
>   means for tracking a consumable use level of the color cartridge
> based on color consumables expended;
>   projecting a color cartridge failure mechanism to be either color
> cartridge wear-out or consumable exhaustion based on the wear level
> and the consumable use level; and
>   means for switching between color mode and monochrome mode to
> decrease likelihood of color cartridge wear-out before color consumables
> are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detect[ing] a change in the state of the print mode actuator", much less "detect[ing] a change in the state of the print mode actuator during the execution of the raster image processing of the document". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "code that detects a change in the state of the print mode actuator during the execution of the raster image processing of the document" as recited in claim 13.

Nor does *Tyson* teach or suggest "transition[ing] the raster image processing of the document at a transition point". Accordingly, *Tyson* does not disclose or suggest "code that transitions the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 13.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 13. Therefore, Applicants respectfully submit that the rejection of claim 13 be withdrawn.

H. Independent Claim 16

Applicants' amended claim 16 provides as follows (emphasis added):

> An image forming device, comprising:
> a *print mode actuator* disposed on the image forming device *having a first state and a second state, where the first state is an application state and the second state is a monochromatic override state*; and
> a print engine configured to implement a printing of at least a portion of a document monochromatically or in color based upon a print mode setting associated with the document and based upon a state of the print mode actuator in the image forming.

Applicants respectfully submit that independent claim 16 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 16.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "a print mode actuator ... having a first state and a second state, where the first state is an application state and the second state is a monochromatic override state" as recited in amended claim 16.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 16. Therefore, Applicants respectfully submit that the rejection of claim 16 be withdrawn.

I.   Dependent Claims 17-23

Since independent claim 16 is allowable, Applicants respectfully submit that claims 17-23 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicants respectfully request that the rejection of claims 17-23 be withdrawn.

J.   Dependent Claim 20

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 20 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 20. Applicants' claim 20 provides as follows (emphasis added):

The image forming device of claim 16, **the print engine is further configured to detect a change in the state of the print mode actuator during an execution of a raster image processing of the document,** wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

The Office Action alleges on pages 4-5 that "Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*])..." (emphasis in original). Applicants respectfully disagree. Applicants respectfully submit that detecting a switch between modes is not the same as "detect[ing] a change in the state of the print mode actuator". Further, while *Tyson* states in claim 3:

> A printer, comprising:
> means for tracking a wear level of a color cartridge based on activity in color mode;
> means for tracking a consumable use level of the color cartridge based on color consumables expended;
> projecting a color cartridge failure mechanism to be either color cartridge wear-out or consumable exhaustion based on the wear level and the consumable use level; and
> means for switching between color mode and monochrome mode to decrease likelihood of color cartridge wear-out before color consumables are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detect[ing] a change in the state of the print mode actuator", much less "detect[ing] a change in the state of the print mode actuator during an execution of a raster image processing of the document". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "the print engine is further configured to detect a change in the state of the print mode actuator during an execution of a raster image processing of the document" as recited in claim 20.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 20. Therefore, Applicants respectfully submit that the rejection of claim 20 be withdrawn.

K.   Dependent Claim 21

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 21 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 21. Applicants' claim 21 provides as follows (emphasis added):

> The image forming device of claim 20, **the print engine is further configured to implement a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.**

The Office Action alleges on pages 4-5 that

> Tyson et al further teaches ... transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

Applicants respectfully disagree. Applicants respectfully submit that *Tyson* does not even mention raster image processing. Nor does *Tyson* teach or suggest "implement[ing] a transition of the raster image processing of the document at a transition point". As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Accordingly, *Tyson* does not disclose or suggest "the print engine is further configured to implement a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 21.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 21. Therefore, Applicants respectfully submit that the rejection of claim 21 be withdrawn.

L. Independent Claim 24

Applicants' amended claim 24 provides as follows (emphasis added):

> An image forming device, comprising:
> means for identifying a print mode setting associated with a document received for printing in an image forming device; and
> means for implementing a printing of at least a portion of a document monochromatically or in color based upon the print mode setting and a state of a print mode actuator in the image forming device, where *the print mode actuator includes at least an application state and a monochromatic override state*.

Applicants respectfully submit that independent claim 24 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 24.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator includes at least an application state and a monochromatic override state" as recited in amended claim 24.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 24. Therefore, Applicants respectfully submit that the rejection of claim 24 be withdrawn.

M.   Dependent Claims 25-26

Since independent claim 24 is allowable, Applicants respectfully submit that claims 25-26 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicants respectfully request that the rejection of claims 25-26 be withdrawn.

N.   Dependent Claim 25

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 25 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 25. Applicants' claim 25 provides as follows (emphasis added):

> The image forming device of claim 24, further comprising ***means for detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document***, wherein the raster image processing is one of a monochromatic raster image processing or a color raster image processing.

The Office Action alleges on pages 4-5 that "Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-8** [*sic*])..." (emphasis in original). Applicants respectfully disagree. Applicants respectfully submit that detecting a switch between modes is not the same as "detecting a change in the state of the print mode actuator". Further, while *Tyson* states in claim 3:

> A printer, comprising:
>   means for tracking a wear level of a color cartridge based on activity in color mode;
>   means for tracking a consumable use level of the color cartridge based on color consumables expended;
>   projecting a color cartridge failure mechanism to be either color cartridge wear-out or consumable exhaustion based on the wear level and the consumable use level; and
>   means for switching between color mode and monochrome mode to decrease likelihood of color cartridge wear-out before color consumables are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detecting a change in the state of the print mode actuator", much less "detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "means for detecting a change in the state of the print mode actuator during an execution of a raster image processing of the document" as recited in claim 25.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 25. Therefore, Applicants respectfully submit that the rejection of claim 25 be withdrawn.

O.   Dependent Claim 26

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 26 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 26. Applicants' claim 26 provides as follows (emphasis added):

> The image forming device of claim 25, further comprising *means for implementing a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.*

The Office Action alleges on pages 4-5 that

> Tyson et al further teaches ... transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

Applicants respectfully disagree. Applicants respectfully submit that *Tyson* does not even mention raster image processing. Nor does *Tyson* teach or suggest "implementing a transition of the raster image processing of the document at a transition point". As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Accordingly, *Tyson* does not disclose or suggest "means for implementing a transition of the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 26.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 26. Therefore, Applicants respectfully submit that the rejection of claim 26 be withdrawn.

P. Independent Claim 27

Applicants' amended claim 27 provides as follows (emphasis added):

> A method, comprising:
> determining a state of a print mode actuator, ***the print mode actuator having at least an application state and a black override state***; and
> executing a color raster image processing of a document if the print mode actuator is in the application state and the document includes a color print setting.

Applicants respectfully submit that independent claim 27 is allowable for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 27.

Further, the Office Action alleges on page 3 that "the print mode actuator reads on the printer mode switch of fig. 2". As such, the Office Action appears to allege that the "print mode actuator" corresponds to switching module 204 (FIG. 2). While *Tyson* teaches "switching

module 204 of the second exemplary version 300 includes a user interface 308, which may be used to announce to the user that mode switching is taking place, and which may additionally present the user with an opportunity to override the mode switching" (col. 3, lines 33-37), *Tyson* does not disclose or suggest "the print mode actuator having at least an application state and a black override state" as recited in amended claim 27.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in amended claim 27. Therefore, Applicants respectfully submit that the rejection of claim 27 be withdrawn.

Q.   Dependent Claims 28-29

Since independent claim 27 is allowable, Applicants respectfully submit that claims 28-29 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicants respectfully request that the rejection of claims 28-29 be withdrawn.

R.   Dependent Claim 29

Notwithstanding, and in addition to, the arguments discussed above, Applicants respectfully request that the rejection of claim 29 be withdrawn for at least the reason that *Tyson* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 29. Applicants' claim 29 provides as follows (emphasis added):

> The method of claim 28, further comprising:
> *detecting a change of the print mode actuator during one of the executing the black raster image processing and the executing the color raster image processing of the document; and*
> *transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a transition point in response to the change in the state of the print mode actuator.*

The Office Action alleges on pages 4-5 that

> Tyson et al further teaches ... detecting a change (**or switch between modes**) in the state of the print mode actuator during the execution of the raster image processing of the document (**see claims 2-**

8 [*sic*]); and transitioning the raster image processing of the document at a transition point in response to the change in the state of the print mode actuator (reads on claims 2-10 [*sic*] which describe how the state of the print can change based on the consumable and user's input).

(Emphasis in original). Applicants respectfully disagree. Applicants respectfully submit that detecting a switch between modes is not the same as "detecting a change of the print mode actuator". Further, while *Tyson* states in claim 3:

A printer, comprising:
    means for tracking a wear level of a color cartridge based on activity in color mode;
    means for tracking a consumable use level of the color cartridge based on color consumables expended;
    projecting a color cartridge failure mechanism to be either color cartridge wear-out or consumable exhaustion based on the wear level and the consumable use level; and
    means for switching between color mode and monochrome mode to decrease likelihood of color cartridge wear-out before color consumables are expended...

(col. 8, lines 27-38), *Tyson* does not disclose or suggest "detecting a change of the print mode actuator", much less "detecting a change of the print mode actuator <u>during one of the executing the black raster image processing and the executing the color raster image processing of the document</u>". *Tyson* does not even mention raster image processing. As is well established in the law, the Examiner must instead consider the claims as a whole. *Net MoneyIN, Inc. v. VeriSign, Inc. et al.*, 545 F.3d 1359 (Fed. Cir. 2008) (the hallmark of anticipation is prior invention, the prior art reference - in order to anticipate under 35 U.S.C. § 102 - must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Connell v. Sears*, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Thus, *Tyson* does not disclose or suggest "detecting a change of the print mode actuator during one of the executing the black raster image processing and the executing the color raster image processing of the document" as recited in claim 29.

Nor does *Tyson* teach or suggest "transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a

transition point". Accordingly, *Tyson* does not disclose or suggest "transitioning between the executing the black raster image processing and the executing the color raster image processing of the document at a transition point in response to the change in the state of the print mode actuator" as recited in claim 29.

For at least the reasons described above, *Tyson* fails to disclose, teach or suggest all of the features recited in claim 29. Therefore, Applicants respectfully submit that the rejection of claim 29 be withdrawn.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-29 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

By: _____
Randy R. Schoen, Reg. No. 62,440

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.
600 Galleria Parkway, SE
Suite 1500
Atlanta, Georgia 30339-5948
Tel: (770) 933-9500
Fax: (770) 951-0933